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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,495	09/02/2003	Masayuki Kumakura	116882	2708
25944	7590	02/23/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			PAREKH, NITIN	
			ART UNIT	PAPER NUMBER
			2811	

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/652,495

Applicant(s)

KUMAKURA, MASAYUKI

Examiner

Nitin Parekh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restriction***

1. Applicant's election with traverse of Group I, claims 1-8 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that in the requirement for an election, Groups I and II differ only in a semiconductor device and method for making the same. Requiring an election based on the above-noted differences would appear to be unwarrant since the fields of search appear to be almost identical. This is not found persuasive because referring to the restriction requirement set forth in the Office Action paper no.2, it clearly shows that the alternative method proposed by the examiner would be distinct from the process claimed. Additionally, the search is not coextensive as evidenced by the different fields of search for the process and product as cited in the previous restriction requirement. Furthermore, Applicant has not provided a convincing argument that the materially different processes would not be suitable in producing the claimed device.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. Figures 5 and 6 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct

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any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art (APA) in view of Matsuura et al. (US Pat. 2001/0015484).

Regarding claims 1-4, the APA discloses a hard disk device comprising an insulating sheet (110 and 113 respectively in Fig. 5), the insulating sheet further comprising:

- a buffer layer (121 in Fig. 5) having buffering attributes, the buffer layer being formed of an urethane foam (see prior art: comparative example 2 in Table 2, page 8) .
- an adhesive layer (122 in Fig. 5), and

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- an insulating resin film (123 in Fig. 5) formed from polyethylene terephthalate/PET (see prior art: comparative example 2 in Table 2, page 8), wherein the buffer layer and the resin film are attached together by the adhesive layer

(Fig. 5 and 6; specification pp. 1, 2, 8 and 9; Table 2).

The APA fails to teach the adhesive layer not being adhesive at normal ambient temperature but exhibiting adhesiveness when heated.

Matsuura et al. teach using a variety of polyester/polyether based heat resistant resin compositions including those without a silicon component (section 0026; 0192; Col. 2-13) to provide improved adhesion/bonding between a variety of substrates/layers (sections 0229 and 0230) where the adhesion/bonding is performed under compression and heat treatment and the temperature of the heat treatment is higher than normal ambient temperature (see sections 0206-0212).

It would have been obvious to a person of ordinary skill in the art at the time invention was made to incorporate the adhesive layer not being adhesive at normal ambient temperature but exhibiting adhesiveness when heated as taught by Matsuura et al. so that the adhesion/bonding, crack resistance and reliability can be improved and moisture absorption can be reduced in the APA's device.

Regarding claim 1, heating the adhesive layer to exhibit adhesiveness, do not distinguish over the APA and Matsuura et al., because only the final product/structure is relevant, not forming the adhesiveness using the "heating", "compressing", "pressurizing and heating" or "softening, curing or melting". Note that a "product by process" claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and *In re Marrosi et al.*, 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear. See also MPEP 706.03(e).

Regarding claims 5-8, the APA and Matsuura et al. teach substantially the entire claimed structure as applied to claims 1-4 above, wherein the APA teaches hard disk device comprising:

- a case (11 in Fig. 5) for housing a hard disk, and
- a printed wiring board (112 in Fig. 5) provided with a circuit for controlling the hard disk.

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Regarding claim 5, heating the adhesive layer to exhibit adhesiveness, do not distinguish over the APA and Matsuura et al., because only the final product/structure is relevant, not forming the adhesiveness using the "heating", "compressing", "pressurizing and heating" or "softening, curing or melting". Note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Fessmann, 180 USPQ 324; In re Avery, 186 USPQ 161; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); and In re Marrosi et al., 218 USPQ 289, all of which make it clear that it is the patentability of the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that applicant has the burden of proof in such cases, as the above case law makes clear. See also MPEP 706.03(e).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nitin Parekh whose telephone number is 571-272-1663. The examiner can normally be reached on 09:00AM-05:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on 571-272-1732. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9318.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

NP

02-12-05



NITIN PAREKH

PRIMARY EXAMINER

TECHNOLOGY CENTER 2800